

Remarks

In the Final Action dated 12/29/2005, the Examiner states that "Applicant's request for reconsideration of the finality of the last Office Action is persuasive and, therefore, the finality of that action is withdrawn". The Examiner is respectfully requested to clarify this statement because the applicants made no such request in their correspondence dated 12/29/2005. That correspondence merely canceled the claims that the Examiner had previously rejected, leaving only those that were previously indicated allowable.

It is, however, respectfully submitted that the current final action is improper. MPEP Section 706(a) reads:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement..."(emphasis added)

The Examiner concedes in the office action that the rejection is a new ground of rejection. The rejection cannot have been necessitated by the applicant's amendment since in the correspondence referred to the applicants merely canceled all the claims in the application except those indicated allowable by the Examiner.

Moreover 706.04 states:

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909).

"Because it is unusual to reject a previously allowed claim, the examiner should point out in his or her office action that the claim now being rejected was previously allowed by using Form Paragraph 7.50.

¶ 7.50 Claims Previously Allowed, Now Rejected, New Art

The indicated allowability of claim [1] is withdrawn in view of the newly discovered reference(s) to [2]. Rejection(s) based on the newly cited reference(s) follow.

The implication is that claims indicated allowable will only be withdrawn in the light of a new reference. Here the Examiner has withdrawn the indication of allowability in the

light of previously cited references in view of his “further consideration”. Since the applicant has not had an opportunity to consider the Examiner’s new ground of rejection, which was clearly not necessitated by the applicant’s amendment, the Examiner is respectfully requested to withdraw the finality of the office action because its finality is inconsistent with MPEP 706(a). If the Examiner raises a new ground of rejection not necessitated by the applicant’s amendment the applicant should have the opportunity to consider it while not under the constraint of a final action.

The error with regard to claim 18 related to an error in the claim listing, which has been corrected.

With regard to the objection to claims 13-22 and 37 -46, it is respectfully pointed out that the Examiner is incorrect. As clearly stated in the passage on page 32, lines 13- 20, the order in which the controller selected for release corresponds to the reverse of the order of priority in which they are released. When a group of connections are to be released, higher priority connections are released first. However, when you have a group of connections in a link, and the bandwidth is reduced by a certain amount so that it can no longer carry all the connections, you have to select which ones to release. In this case, the lower priority connections are selected for release first, leaving the higher priority connections to be carried by the portion of the link remaining in good standing. Once a subset of connections have been selected for release, then the connections within this subset are released in the order from the highest priority to the lowest priority. The objection with regard to these claims is therefore respectfully traversed.

With regard to the Examiner’s new ground rejection of claim 12, which he had previously indicated as allowable, it is respectfully pointed out that Arslan contains no teaching of selecting a group of connections from a number of connections corresponding to a reduction in bandwidth. It is fundamental in patent law that one must not read into a reference a teaching that is not present. In the passage referred to by the Examiner at Col. 7, lines 8,9, Arslan merely states that “not all the channels carried over the link need have failed”. Firstly, it is not entirely clear what this statement means because the circuits are typically trunks, which each carry a number of channels. At col. 7. line 16, Arslan states that an alarm is triggered if a circuit or a portion of a circuit has failed. This implies if any of the channels within a circuit fail, the entire circuit is restored. It says nothing about

Appl. No. 09/275,097
Amdt. Dated 03/29/2005
Response to Final Action mailed 12/29/2005

channels within a circuit. Secondly, Arslan's statement that some of the channels may fail does not imply a reduction in the bandwidth capacity of the link. The fact that a circuit within a link has failed does not mean that the link is not capable of carrying the circuit. The bandwidth capacity of the link remains the same in the event of channel failure.

In accordance with the invention, when the carrying capacity of the link is reduced, a decision is made to release a sufficient number of circuits to compensate for the reduction in bandwidth. These circuits have not necessarily failed as taught by Arslan, which cannot be regarded as a teaching of the "upon detection" step of claim 12.

With regard to claim 13, the Examiner's rejection seems to be based on the false premise that the wording of the claim is incorrect. Such rejection is respectfully traversed because clearly the prior art does not teach selecting connections for release based on the lowest priority connection first.

Similar arguments apply *mutatis mutandis* to apparatus claims 34 and 37.

The Examiner's initial position prior to his "further consideration" with regard to allowability of the claims on file was correct. He is therefore respectfully requested to withdraw his reversal of his previous position and allow the application in its present form consistent with the position taken in the final action dated 08/03/2005.

Accordingly, reconsideration and allowance are respectfully requested.

Respectfully submitted,



Richard J. Mitchell
Registration No. 34,519
Patent Agent

MARKS & CLERK
P. O. Box 957, Station B,
Ottawa, Ontario
Canada K1P 5S7
(613) 236-9561